

REMARKS

This Application has been carefully reviewed in light of the Final Office Action mailed May 2, 2008. At the time of the Office Action, Claims 1, 3, 4, 7-10, 13, and 14 were pending in this Application. Claims 1, 3, 4, 7-10, 13, and 14 were rejected. Claims 2, 5 and 6 were previously cancelled without prejudice or disclaimer and Claims 11, 12 and 15-36 were previously cancelled due to an election/restriction requirement. Claims 37-45 are new. Applicant respectfully requests reconsideration and favorable action in this case.

Rejections under 35 U.S.C. §103

Claims 1, 3, 4, 7-10, 13 and 14 stand rejected under 35 U.S.C. §103(a) as being unpatentable over “High Surface Area Substrates for DNA Arrays” *Materials Research Society Symposium Proceedings*, p. 371-376, by M. Glazer et al. (“Glazer”) and U.S. Patent No. 5,629,186 issued to Robert D. Yasukawa et al. (“Yasukawa”). Claims 1, 3, 4, 7-10, 13 and 14 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,959,098 issued to Martin Goldberg et al. (“Goldberg”) and Yasukawa. Applicant respectfully traverses and submits that the cited art combinations, even if proper, which Applicant does not concede, do not render the claimed embodiment of the invention obvious.

In order to establish a prima facie case of obviousness, the references cited by the Examiner must disclose all claimed limitations. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). Even if each limitation is disclosed in a combination of references, however, a claim composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. *KSR Int'l. Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741 (2007). Rather, the Examiner must identify an apparent reason to combine the known elements in the fashion claimed. *Id.* “Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *Id.*, citing *In re*

Kahn, 441 F.3d 977, 988 (Fed. Cir. 2006). Finally, the reason must be free of the distortion caused by hindsight bias and may not rely on ex post reasoning. *KSR*, 127 S.Ct. at 1742. In addition, evidence that such a combination was uniquely challenging or difficult tends to show that a claim was not obvious. *Leapfrog Enterprises, Inc. v. Fisher-Price, Inc. and Mattel, Inc.*, 485 F.3d 1157, 1162 (Fed. Cir. 2007), citing *KSR*, 127 S.Ct. at 1741.

Even assuming that Glazer and Yasukawa are properly combined, which Applicant does not concede, the combination fails to disclose, teach, or suggest the claimed invention. The Examiner admits that Glazer fails to disclose the fused fiber porous material of Claim 1 and relies on Yasukawa for that material. Yasukawa, however, fails to disclose such a material.

First, the Examiner admits that the Yasukawa must disclose a material with a pore size as recited in Claim 1 because it allegedly contains the same components as the material claimed in claim 1. Even assuming the components are identical, which Applicant does not concede, this in no way implies that the pore size is identical or even similar. The current specification and patent cited therein indicates that pore size may vary based on the conditions other than the basic composition of a fused fiber porous material. For example, the dimensions of the polymer fibers can play an important role in pore size. The current specification indicates that “longer fibers lead to a more open matrix structure,” which often correlates with larger pores. (p. 8, lines 9-10.) Yasukawa itself states that fiber length may affect pore size. (See Col. 1, lines 31-35; Col. 2, lines 16-18; and particularly Col. 4, lines 53-59.) Accordingly, based on the current specification and the Examiner’s own cited art, one of ordinary skill in the art would at least need to know information about the fiber dimensions of the material in Yasukawa to have any idea of its pore size. Yasukawa, therefore, fails to disclose at least this element in Claim 1 either explicitly or inherently and also fails to provide any suggestions that such a pore size should be used.

Second, Yasukawa does not, as the Examiner contends, disclose a fused fiber porous material all of which consists of a density of at least six pounds per cubic foot. The Examiner relies on Claim 8 of Yasukawa, which claims “the matrix of claim 1 having, in one matrix dimension, a matrix gradient progressing between a selected density 3.5-5.0 pounds/ft³ to a selected density of 5.5 to 12 pounds/ft³,” as reciting this claim limitation. This claim of

Yasukawa on its face does not disclose a material *all of which* consists of a density of at least six pounds per cubic foot. The claim language clearly specifies that part of the material in the matrix gradient has a density of 3.5-5.0 pounds/ft³. Claim 8 of Yasukawa also fails to teach the current limitation of a material all of which consists of a density of at least six pounds per cubic foot; in fact it teaches against this. Specifically, Claim 8 is dependent on Claim 1. This means that the material having the gradient described in Claim 8 must also meet all requirements of Claim 1. One such requirement is that the "porous matrix" is "characterized by: ... a density of between 3.5 and 5.5 pounds/ft³." The Examiner clearly assumes (but Applicant does not admit) that this "porous matrix" is the same as the "fused fiber porous material" of Applicant's claims. Based on this assumption, Yasukawa discloses a "fused fiber porous material" all of which has a density of between 3.5 and 5.5 pounds/ft³ overall, although in the embodiment described in Claim 8 it may have a higher density in some regions. A "fused fiber porous material" with a density of between 3.5 and 5.5 pounds/ft³ is outside the scope of Applicants current claims. As a result, Yasukawa fails to disclose, teach or suggest the material of Claim 1 for this reason as well.

New Claim 37 has been added and is similar to Claim 1, but claims a material a material all of which consists of a density of at least twelve pounds per cubic foot. Yasukawa fails to disclose a material of this density.

Applicant submits that Claims 1 and 37 and all claims dependent thereon are patentable over the cited are. Allowance of these claims is requested.

Request for Continued Examination (RCE)

Applicant respectfully submits a Request for Continued Examination (RCE) Transmittal and authorizes the Commissioner to charge the \$405.00 RCE fee and any fees required to Deposit Account 50-2148 in order to effectuate this filing.

CONCLUSION

Applicant has now made an earnest effort to place this case in condition for allowance in light of the amendments and remarks set forth above. Applicant respectfully requests reconsideration of all claims.

Applicant encloses a Petition for a one-month extension of time with this response and a Request for Continued Examination (RCE) is also filed herewith. Applicant authorizes the Commissioner to charge the \$60.00 fee for one-month extension of time and \$405.00 fee for the RCE to Deposit Account No. 50-2148 of Baker Botts L.L.P. The Commissioner is hereby authorized to charge any additional fees necessary or credit any overpayment to Deposit Account No. 50-2148 of Baker Botts L.L.P.

If there are any matters concerning this Application that may be cleared up in a telephone conversation, please contact Applicant's attorney at 512.322.2580.

Respectfully submitted,
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Date: 9/27/08

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